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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/084,578 | 02/27/2002 | James L. DiGuiseppi | 9250-29 | 6023 |

20792 7590 05/19/2004
MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

EXAMINER

LEARY, LOUISE N

ART UNIT PAPER NUMBER

1654

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/084,578 | DIGUISEPPI ET AL. | |
| | Examiner | Art Unit | |
| | Louise N. Leary | 1654 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1. Claims 1-28 are pending in this application.
2. The nonstatutory double patenting rejections of some or all of claims 1-28 have been maintained for reasons of record.
3. Applicant's arguments filed March 1, 2004 have been fully considered but they are not persuasive.

The examiner has carefully considered applicant's request for reconsideration and arguments for withdrawal of the obviousness- type double patenting rejections.

However, claims 1-28 remain rejected as unpatentable over claims 1-28 of US Patent No. 5,164,796 because both inventions use semi-permeable membranes or compositions. Also, the examiner agrees with applicant's statement that "[The membrane or composition only permits the passage of gas molecules.]" which clearly implies "filter" means are operational in the invention claimed in US Patent 5,164,796. The instant invention claims filter means. In addition, gas molecules are or may be filtered from liquid or solid state compositions claimed in both inventions. Thus, there is substantial overlap of the subject matter claimed in both inventions.

Secondly claims 1-21 remain rejected as unpatentable over claims 1-21 of US Patent No. 5,094,955 because both inventions use semi-permeable membranes or compositions. The examiner agrees with applicant's statement that "[The membrane or composition only permits the passage of gas molecules.]" which clearly implies "filter" means are operational in the invention claimed in US Patent 5,164,796. It is noted that

the instant invention claims filter means. In addition, gas molecules are or may be filtered from liquid or solid state compositions claimed in both inventions. Thus, there is substantial overlap of the subject matter claimed in both inventions.

Likewise, claims 22-28 remain rejected as unpatentable over claims 1-21 of US Patent No. 5,217,876 because both inventions use semi-permeable membranes or compositions. The examiner agrees with applicant's statement that "[The membrane or composition only permits the passage of gas molecules.]" which clearly implies "filter" means are operational in the invention claimed in US Patent 5,164,796. It is noted that the instant invention claims filter means. In addition, gas molecules are or may be filtered from liquid or solid state compositions claimed in both inventions. Thus, there is substantial overlap of the subject matter claimed in both inventions.

Further, the examiner notes for the record that the nonstatutory double patenting statute does not require instant claims 1-28 to be identical to the claims in US Patents 5,164,796; 5,094,955 nor 5,217,876. There is substantial overlap of the subject matter claimed in each invention for reasons described above. Thus, the nonstatutory double patenting rejections have been maintained because the subject matter claimed in the inventions are not patentably distinct.

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louise N. Leary whose telephone number is (571) 272-0966. The examiner can normally be reached on Monday to Friday from 10 to 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the
Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LOUISE N. LEARY
PRIMARY EXAMINER

May 15, 2004